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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,381	10/16/2003	Thierry Fleurence	1948-4821	2245
27123	7590	08/04/2009		
MORGAN & FINNEGAN Transition Team C/O Locke Lord Bissell & Liddell 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER PICKARD, ALISON K	
			ART UNIT 3676	PAPER NUMBER
			NOTIFICATION DATE 08/04/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/688,381

**Applicant(s)**

FLEURENCE, THIERRY

**Examiner**

Alison K. Pickard

**Art Unit**

3676

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-7, 10, 11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6, 7, 10, 11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Note: it is unclear if Applicant is now claiming the combination of the seal and optical unit due to some of the wording in the new limitations (e.g. section about compressive force, etc added to end of the claims). For purposes of examination, the claims are still being interpreted as subcombination claims wherein only the seal is being positively claimed and is capable of functioning in the intended environment.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Sellw.

Sylvester discloses a gasket comprising a sheet of flexible material having an orifice (figure 2). The sheet can have various materials of different hardness, a skin, and a cellular material. Sylvester does not disclose a lip on an edge of the seal. Sellw teaches a seal having flexible sheet and an orifice. Sellw teaches using a lip(s) to improve sealing particularly where there are imperfections in the mating surface (see col. 2, lines 28-39). Thus, Sellw provides a teaching of a lip at any location where improved sealing is necessary. Providing the lip(s) only at the first surface of the first side (i.e. no lip at the second surface) is considered obvious in a situation where that is the only location there may be imperfections. Therefore, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to use a lip on the first surface as taught by Sellew to improve sealing.

Regarding claim 3, Sylvester does not specifically disclose cellular EPDM. The selection of a known material based on its suitability for its intended use is not considered inventive. See *In re Leshin* 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use cellular EPDM in the sheet.

3. Claims 6, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Sellew in view of Hance.

Sylvester discloses a gasket comprising a sheet of flexible material having an orifice (figure 2). The sheet can have various materials of different hardness, a skin, and a cellular material. Sylvester does not disclose a lip on an edge of the seal. Sellew teaches a seal having flexible sheet and an orifice. Sellew teaches using a lip(s) to improve sealing particularly where there are imperfections in the mating surface (see col. 2, lines 28-39). Thus, Sellew provides a teaching of a lip at any location where improved sealing is necessary. Providing the lip(s) only at the first surface of the first side (i.e. no lip at the second surface) is considered obvious in a situation where that is the only location there may be imperfections. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a lip on the first surface as taught by Sellew to improve sealing.

Sylvester does not appear to disclose the central portion is more rigid than the top and bottom portions. Hance teaches a gasket having reinforcement in the material. Hance teaches that the reinforcement can be through out the whole body or just in a portion (such as a center portion of the gasket). It would have been obvious to one of ordinary skill in the art at the time

the invention was made to modify Sylvester such that a reinforcement is only in the center of the gasket. The use of a known technique to improve a similar device in the same way is obvious.

Regarding claim 7, the lip would be made of material 32 and would have a different hardness than the sheet comprising all materials 32, 34, 36, etc.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Sellw as applied to claim 10 above, and further in view of Johnson.

Sellw does not appear to disclose the lips (Fig. 6) are different heights. Johnson teaches a gasket with plural sealing lips. Johnson teaches using different heights to ensure a seal is formed even if the seal is not evenly or properly clamped between surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the lips different height to ensure a seal under all clamping forces.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Sellw in view of Hance as applied to claim 13 above, and further in view of Johnson (5,090,713).

Sellw does not appear to disclose the lips (Fig. 6) are different heights. Johnson teaches a gasket with plural sealing lips. Johnson teaches using different heights to ensure a seal is formed even if the seal is not evenly or properly clamped between surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the lips different height to ensure a seal under all clamping forces.

6. Claims 1, 3, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Ishikawa (5,427,389).

Sylvester discloses a gasket comprising a sheet of flexible material having an orifice (figure 2). The sheet can have various materials of different hardness, a skin, and a cellular material. Sylvester does not disclose a lip on an edge of the seal. Ishikawa teaches a gasket with sealing lip 12b used to improve the seal between bolt holes (which Sylvester can have). The lip is only provided on sides of the gasket. Therefore, there would be portions (e.g. top and bottom similar to that in Ishikawa) of a rectangular gasket (for example) that would not have a lip as required. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gasket of Sylvester with a lip only on a side as taught by Ishikawa since the use of a known method to improve a similar device yields expected results.

Regarding claim 3, Sylvester does not specifically disclose cellular EPDM. The selection of a known material based on its suitability for its intended use is not considered inventive. See *In re Leshin* 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use cellular EPDM in the sheet.

7. Claims 6, 7, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Ishikawa in view of Hance.

Sylvester discloses a gasket comprising a sheet of flexible material having an orifice (figure 2). The sheet can have various materials of different hardness, a skin, and a cellular material. Sylvester does not disclose a lip on an edge of the seal. Ishikawa teaches a gasket with sealing lip 12b used to improve the seal between bolt holes (which Sylvester can have). The lip is only provided on sides of the gasket. Therefore, there would be portions (e.g. top and bottom similar to that in Ishikawa) of a rectangular gasket (for example) that would not have a lip as required. It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the gasket of Sylvester with a lip only on a side as taught by Ishikawa since the use of a known method to improve a similar device yields expected results.

Sylvester does not appear to disclose the central portion is more rigid than the top and bottom portions. Hance teaches a gasket having reinforcement in the material. Hance teaches that the reinforcement can be through out the whole body or just in a portion (such as a center portion of the gasket). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sylvester such that a reinforcement is only in the center of the gasket. The use of a known technique to improve a similar device in the same way is obvious. Regarding claim 7, the lip would be made of material 32 and would have a different hardness than the sheet comprising all materials 32, 34, 36, etc.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Ishikawa as applied to claim 10 above, and further in view of Johnson.

Ishikawa does not appear to disclose plural lips with different heights. Johnson teaches a gasket with plural sealing lips. Johnson teaches using different heights to ensure a seal is formed even if the seal is not evenly or properly clamped between surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use plural lips with different height to ensure a seal under all clamping forces.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Ishikawa in view of Hance as applied to claim 13 above, and further in view of Johnson (5,090,713).

Ishikawa does not appear to disclose plural lips with different heights. Johnson teaches a gasket with plural sealing lips. Johnson teaches using different heights to ensure a seal is formed

even if the seal is not evenly or properly clamped between surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use plural lips with different height to ensure a seal under all clamping forces.

***Response to Arguments***

10. Applicant's arguments filed 4-17-09 have been fully considered but they are not persuasive.

Applicant argues that Sellew teaches the bead must be concentric and continuous. The examiner disagrees. Sellew does not appear to disclose any where that the lip must be concentric or continuous. While it is shown that way in the figures, Sellew also states that the specification is not limited to the Figures (see last column lines 24-27). The examiner maintains that Sellew teaches the use of a bead where need to improve sealing. Ishikawa has also been applied for its similar teaching. Ishikawa teaches beads only at edges of a gasket. Modifying the gasket of Sylvester with this teaching would result in a second portion free of a lip as claimed. Again, the use of a sealing lip to improve sealing is well known.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO



MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alison K. Pickard/  
Primary Examiner, Art Unit 3676

AP